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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/605,546

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Alan E. Stein

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EXAMINER

KERNS, KEVIN P

ART UNIT

PAPER NUMBER

1725

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/605,546	Applicant(s) STEIN ET AL.	
	Examiner Kevin P. Kerns	Art Unit 1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005 and 19 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2003 and 16 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-43 of copending Application No. 10/604,459. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims include at least the following common features: a welding torch configured to present an electrode to a weld; an enclosure (welder housing); a power conditioner (power source/supply) disposed within the enclosure; a cooling system having a coolant tank and a spout disposed within the enclosure to circulate coolant through the welding torch/component via coolant hoses (providing supply and return paths for the coolant); a controller operable to control the cooling system and power conditioner; a means to automatically commence coolant circulation through the torch when the electrode is presented to the weld; a means to maintain coolant circulation until expiration of a specific time period

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and until a temperature falls below a certain value; a heat exchanger and water pump assembly; and at least one check valve integrated with the cooling system. One of ordinary skill in the art would have recognized that the additional features present for the welding-type system of copending Application No. 10/604,459 would selectively be present on the welder of the present application, as open-ended "comprising" language is present in the current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-25, 27-35, 37-40, 44, 45, 48-50, and 54 of copending Application No. 10/708,657 (US 2005/0205542). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims include at least the following common features: a welding torch configured to present an electrode to a weld; an enclosure (welder housing); a power conditioner (power source/supply) disposed within the enclosure; a cooling system having a coolant tank and a spout disposed within the enclosure to circulate coolant through the welding torch/component via coolant hoses (providing supply and return paths for the coolant); a controller operable to control the cooling system and power conditioner; a means to automatically commence coolant circulation through the torch when the electrode is presented to the weld; a means to maintain coolant circulation until expiration of a specific time period and until a temperature falls

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below a certain value; a heat exchanger and water pump assembly; and at least one check valve integrated with the cooling system. One of ordinary skill in the art would have recognized that the additional features present for the welding-type system of copending Application No. 10/708,657 would selectively be present on the welder of the present application, as open-ended "comprising" language is present in the current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Prunier (FR 2 536 320) or Behnke et al. (US 2,510,207) in view of Bailey (US 5,266,778).

Prunier discloses an arc welding machine that includes a refrigeration unit for torch cooling, in which the welding machine further includes a welding torch configured to present an electrode to a weld; an enclosure (welder housing) with a base plate, side plates, end plates, and a top cover; a power conditioner (power source/supply) disposed within the enclosure; a cooling system having a coolant tank and a spout disposed within the enclosure to circulate coolant through the welding torch/component via coolant hoses (providing supply and return paths for the coolant); a controller operable to control the cooling system and power conditioner; a means to automatically commence coolant circulation through the torch when the electrode is presented to the weld; a means to maintain and terminate coolant circulation; a heat exchanger and water pump assembly; and at least one check valve integrated with the cooling system (abstract; translated French text of specification and claims in the paragraph bridging pages 3 and 4, the paragraph bridging pages 6 and 7, the detailed description on pages 7-11, the last two paragraphs on page 11 and bridging to page 12, claims 5 and 6; and Figure).

Also, Behnke et al. disclose a fluid control system for inert gas blanketed arc welding, in which the welding machine further includes a welding torch T with a cooling jacket J configured to present an electrode E to a workpiece to be welded W; a power

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conditioner (power source/supply); a cooling system having a coolant tank (manifold) and a spout operable to circulate coolant through the welding torch/component via coolant hoses (providing supply and return paths for the coolant); a controller operable to control the cooling system and power conditioner; a means to automatically commence coolant circulation through the torch when the electrode is presented to the weld; a means to maintain and terminate coolant circulation; a heat exchanger and water pump assembly; and at least one check valve integrated with the cooling system (column 1, line 1 through column 3, line 61; and Figure).

Neither Prunier nor Behnke et al. specifically discloses a means to maintain coolant circulation until expiration of a specific time period and/or until a temperature falls below a certain value (i.e. threshold, predetermined value, and/or certain set point after deactivation of the welding machine), in which one or more temperature sensors in cooperation with a dynamic control means would be required.

However, Bailey discloses a dynamic temperature control for use with a heating/cooling system having a fluid reservoir 28 including at least one temperature sensor (fluid temperature sensor 30 and remote temperature sensor 32), in which the dynamic temperature control 10 (see Figure 1) includes logic circuitry to receive temperature input signals from a control panel and at least one temperature sensor (30,32) to control the operating temperature of the fluid circulated through the fluid circulating system, and is operable to receive a temperature set point signal (column 3, lines 3-14) corresponding to a desired temperature set point from a temperature set point control 22, such that the temperature sensors in cooperation with a dynamic

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control means are advantageous for providing accurate, dynamic control of fluid temperature until expiration of a specific time period and/or until a temperature falls below a predetermined certain value, or set point (abstract; column 1, lines 9-11; column 2, lines 15-68; column 3, lines 1-14 and 55-68; column 4, lines 1-39 and 67-68; column 5, lines 1-2 and 40-47; and Figures 1-3).

It would have been obvious to one of ordinary skill in the art at the time the applicants' invention was made to modify either of the arc welding machines disclosed individually by Prunier and Behnke et al., by using a temperature sensor in cooperation with a control means to maintain coolant circulation while establishing a desired temperature set point, as taught by Bailey, in order to provide accurate, dynamic control of fluid temperature until expiration of a specific time period and/or until a temperature falls below a predetermined certain value, or set point (Bailey; abstract; column 1, lines 9-11; column 2, lines 15-68; and column 3, lines 1-14).

Response to Arguments

7. The examiner acknowledges the applicants' after final amendment and pre-appeal brief review filed with a notice of appeal, which were received by the USPTO on September 22, 2005 and January 19, 2006, respectively. Upon discussion at a pre-appeal brief review conference conducted on February 28, 2006, it was determined that prosecution be reopened on claims 1-23, and thus new grounds of rejection are presented in above sections 3 and 6 (double patenting and 35 USC 103(a) rejections, respectively). The applicants' after final amendment overcomes prior objections to the

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specification, as well as prior 35 USC 112, 2nd paragraph rejections of claims 12-17.

Provisional double patenting rejections remain (see paragraph 2). Claims 1-23 remain under consideration in the application.

8. Applicants' arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

With regard to the applicants' remarks/arguments on pages 11-15 of the applicants' after final amendment, in addition to the remark/arguments on pages 1-5 of the pre-appeal brief review, the applicants are referred to above paragraphs 3 and 6 for the new grounds of rejection, in which the primary references (Prunier and Behnke et al.) fail to specifically disclose a means to maintain coolant circulation until expiration of a specific time period and/or until a temperature falls below a certain value, in which one or more temperature sensors in cooperation with a dynamic control means would be required. The Bailey reference, which clearly includes temperature sensors and a dynamic control means, is newly applied to remedy the deficiencies of Prunier and Behnke et al., and all of claims 1-23 are now rejected under 35 USC 103(a).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Bernard and Carollo references are also cited in PTO-892.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571) 272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin P. Kerns *Kevin Kerns 3/19/06*
Primary Examiner
Art Unit 1725

KPK
kpk
March 19, 2006